12-17-01 AF/1731

OIPE JC186 DEC 17 2001 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 1731

HAROLD A. McMASTER ET AL.

Examiner: S. Vincent

Serial No.: 08/655,853

Filed: May 30, 1996

For: GLASS SHEET BENDING AND TEMPERING APPARATUS

Attorney Docket No.: GLT 1618 R

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REPLY BRIEF

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Sir:

A. Preliminary Matters

Appellants note that the Examiner has withdrawn the rejection of claims 27 and 30 under 35 U.S.C. § 112, paragraph 1. Applicants agree with the Examiner that the only

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issue remaining on appeal is whether Applicants are barred from obtaining allowance on claim 27 under the recapture doctrine.[1]

B. The Prosecution History of this Case Reveals That Applicants Did Not Intend To Surrender The Subject Matter of Claim 30

Standing alone, Applicants' cancellation of claims 12-14 in the parent application[2] is evidence that Applicants surrendered the subject matter of those claims. However, the mere cancellation of claims is not dispositive evidence of surrender. All the circumstances of the file history should be considered to determine whether Applicants intended to surrender any subject matter.

In this case, Applicants' filing of a continuation application entitled "Bent Glass Sheet ***Quench***" (emphasis added), clearly negates any inference from the cancellation of claims 12-14 in the parent that Applicants intended to surrender all potentially patentable subject matter relating to the quench portion of Applicants' invention. Moreover, the Examiner's contention that Applicants' omission of claims directed to the tempering apparatus in the continuation application "reinforces the original surrender" flies in the face of the only relevant affirmative action taken by Applicants -- the retitling of the application identifying their invention as a quench.

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[1] Applicants also agree that the Examiner's presentation of claim 30, contained in the Appendix to the Examiner's Answer, is correct. However, in light of the Examiner's withdrawal of the rejection under 35 U.S.C. § 112, paragraph 1, claim 30 is no longer at issue on this appeal.

[2] Claims 12-14 were omitted in application Serial No. 07/083,685, the parent application of Serial No. 07/249,718, which issued into U.S. Patent No. 4,883,527, which is the subject of this reissue application.

It should be noted that in each of the cited cases where the recapture doctrine was applied, the evidence supporting the conclusion that the applicants surrendered subject matter included the submission of amended or new, narrower claims in response to a rejection, coupled with arguments to the Examiner that clearly indicated that the newer amended claims did not include subject matter (the surrendered subject matter) as part of the applicants' claimed invention. *See in Re Clement,* 131 F.3rd 1464 (Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993); *Pannu v. Storz Instruments, Inc.*, 258 F.3rd 1366 (Fed. Cir. 2001). The absence of any arguments or other affirmative evidence in the file history indicating an intent to surrender subject matter, coupled with the affirmative act of changing the title of the invention clearly indicate applicants' intention to pursue their claims for their quench invention, and compel a finding that there was no surrender of subject matter in this case.

The Examiner's position that "subject matter cannot be 'un-surrendered'" misses the point. The fact of whether a surrender occurred is to be determined from *all* the circumstances of the prosecution history. The Examiner treats the cancellation of the broader quench claims in the parent as an irrebuttable presumption of surrender. There is no law which supports this approach.

C. The Test For Recapture Requires Comparison Of The Later Claimed Subject Matter To The Subject Matter Surrendered During The Original Prosecution

The Examiner purports to find recapture in this case because claim 27 is broader in one respect than the patented claims. This is a flawed analysis. A patent applicant does not surrender all subject matter that is not originally patented. If so, the recapture doctrine would eliminate all broadening reissues.

Assuming for the sake of argument that some subject matter was surrendered, the proper comparison is presented by Applicants. That is, is the subject matter of claim 27 the same subject matter surrendered by the cancellation of claims 12-14 during the prosecution of the parent application? Again, Applicants say no. The scope of claim 27 is narrower in many material respects than the original claims 12-14.[3] As such, under *In re Clement* and its progeny, claim 27 is not an improper recapture of subject matter.

In light of the foregoing, the Examiner's rejection of claim 27 should be reversed, and Applicants' reissue application should proceed to allowance.

Respectfully submitted,

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[3] A listing of the elements found in claim 27 and not found in any of cancelled claims 12-14 is presented at pages 14-15 of Appellants' Appeal Brief.